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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,199	11/17/2003	Karissa L. Eckert	86093JLT	3341

7590

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EXAMINER

SCHILLING, RICHARD L

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/715,199

Applicant(s)

ECKERT ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 1, 2, 4, 6-8, 11-13, 15, 17 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masukawa et al. in view of Gutman for the same reasons as set forth in paragraph 1 of the last office action filed 5-25-05. Applicants' argument that Masukawa et al. is directed to color photography is unconvincing since Masukawa et al. ( col. 5, lines 30-43 ) includes formation of black and white silver images. Example 1 with phthalic acid and silver benzotriazole does not form color dye images. Applicants' argument that Masukawa et al. does not provide motivation to select ascorbic acid from among the disclosed reducing agents is unconvincing since Gutman discloses ascorbic acid as preferred for use with silver benzotriazoles as in example 1 of Masukawa.

2. Claims 1-4, 6-13, 15, 17, 26, 28, 30, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai et al. in view of Gutman for the same reasons as set forth in paragraph 2 of the last office. Applicants' argument that Hirai does not mention shelf aging fog is unconvincing since the acids in Hirai et al., including the polycarboxylic acids, are used for high stability prior to thermal development. The materials of Hirai et al. ( col. 7, lines 51-55 ) may be used for silver images as well as color images; and the materials in Hirai et al. ( col. 13, lines 24-65 ) contain hydrophilic binders and toners as set forth in instant claim 34. While many acids are disclosed in Hirai et al. as argued by applicants, polycarboxylic acids are still listed among the preferred acids.

3. Claims 1, 2, 4-8, 11-13, 15-28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano et al. in view of Gutman for the same reasons as set

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forth in paragraph 3 of the last office action. Applicants' argument that Hirano et al. disclose many carboxylic acids is unconvincing since they all have two carboxylic acid groups as required by instant claim 2. Sample I-10 in applicants' specification has only one carboxylic acid group.

4. Claims 5, 16 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirai et al. in view of Gutman further in view of Hirano et al. for the same reasons as set forth in paragraph 4 of the last office action.

5. Claims 18-25 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Masakawa et al. and Gutman as applied in paragraph 1 above, the combination of Hirai et al. and Gutman as applied in paragraph 2 above, the combination of Hirai et al., Hirano et al. and Gutman as applied in paragraph 4 above or the combination of Hirano et al. and Gutman as applied in paragraph 3 above all further in view of Lyons et al. and Simpson et al. for the same reasons as set forth in paragraph 5 of the last office action.

6. Claims 1, 2, 4, 6-8, 11-13, 15, 17, 26-28 and 30 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gutman for the same reasons as set forth in paragraph 7 of the last office action. Applicants' argument that the binders in Gutman are hydrophobic is unconvincing since Gutman ( col. 5, lines 17-20 ) disclose polyvinyl alcohol binders as one out of five disclosed binders.

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7. Claims 5, 16 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman in view of Hirano et al. for the same reasons as set forth in paragraph 8 of the last office action.

8. Claims 18, 19, 23-25 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman in view of Lyons et al. and Simpson et al. for the same reasons as set forth in paragraph 9 of the last office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1160 1752

